

AMENDMENT

Serial Number: 09/146,069

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communication executed through the Internet.

- sub B4)
AS
C-12
20. (Amended) A communication apparatus comprising:
transmission means for transmitting data; and
notification means for notifying, by a method different from that of the transmission means,
that the transmission means is prepared to transmit the data.
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- sub B5)
Ag
22. (Amended) A communication apparatus comprising:
first means for sending data over a first communication network;
second means for sending data over a second communication network;
third means for controlling the first means and the second means;
wherein the third means controls the second means so as to send data corresponding to the
sending operation of the first means, and
wherein the sending operation of the second means indicates that the first means is prepared
to send data over the first communication network.
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REMARKS

The above Amendment and following remarks are responsive to the points raised in the Office Action dated November 8, 2000. The Applicant respectfully requests entry of this Amendment, favorable reconsideration of this case, and early issuance of a Notice of Allowance.

Status of the Claims

Upon entry of this Amendment, claims 2, 5, 10-12, 15-19, 20, and 22 will have been

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rewritten, and claims 1-25 are pending in the application. Claims 1, 3, 5, 9-12, 18-20, 22 are in independent form. This Amendment does not introduce new matter.

Note to the Examiner

For the Examiner's convenience, the Applicant notes that claims 2 and 3 should be renumbered to claims 3 and 2, respectively, when the application is ready for allowance.

Response to the Rejection under 35 U.S.C. § 112, ¶ 2

Claims 16-19 were rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. The Examiner noted that antecedent basis is lacking for:

- The limitations “the summarized text”, “the summary”, “the information”, and “the first page” in claim 16;
- The limitation “the number of pages” in claim 17;
- The limitation “the Internet communication execution step” in claim 18; and
- The limitations “the Internet communication execution step” and “the notification step” in claim 19.

The Applicant has amended claims 16-19 in response to this rejection to provide clear antecedent basis. In addition, the Applicant has amended claim 15 to provide proper antecedent basis for the limitation “the number of pages”. Thus, the Applicant respectfully submits that the Examiner should withdraw this rejection.

Response to the Rejection under 35 U.S.C. § 102(a)

Claims 12, 13, 18, and 19 have been rejected under 35 U.S.C. § 102(a) as being

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anticipated by Kulakowski, WIPO Publication Number WO 97/10668 (hereinafter Kulakowski).

The Applicant respectfully traverses this rejection.

Kulakowski discloses a device and method for transmitting or receiving facsimile messages through a packet switched computer network accessible through a public switched telephone network. The Kulakowski device and method converts facsimile data into an electronic mail message and transmits the electronic mail message to a service provider for delivery to the recipient through the packet switched computer network. Kulakowski discloses three methods for the recipient to receive delivery of the electronic mail message. First, the device may forward the electronic mail message to the recipient immediately upon receiving the message. Second, the service provider may establish a telephone connection with the recipient's device and download the electronic mail message to the recipient. Finally, the recipient may program his device to establish a telephone connection with the service provider and upload the electronic mail message to the recipient.

Independent claim 12 and dependent claim 13, as presently claimed, recite a communication apparatus comprising an Internet communication execution means that establishes a dial-up connection to an Internet service provider and a notification means that signals a recipient when the dial-up connection is established. The notification is representing that facsimile communication has been executed by the execution means. In contrast, the Kulakowski device and method sends the electronic mail message to the recipient after receipt of the message. Thus, Kulakowski cannot anticipate the Applicant's communication apparatus because Kulakowski does not disclose a system that notifies the recipient after establishment of

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the dial-up connection.

Independent claims 18 and 19, as presently claimed, recite a control method for a communication apparatus comprising establishing a dial-up connect to execute communication and notifying the recipient when the dial-up connection is established. In contrast, the Kulakowski device and method sends the electronic mail message to the recipient after receipt of the message. Thus, Kulakowski cannot anticipate the Applicant's communication apparatus because Kulakowski does not disclose a system that notifies the recipient after establishment of the dial-up connection.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Response to the Rejections under 35 U.S.C. § 102(e)

Claims 1 and 9 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Gordon, U.S. Patent Number 5,608,786 (hereinafter Gordon). Claims 1, 2, 9, and 10 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Ho et al., U.S. Patent Number 5,805,298 (hereinafter Ho). Claim 20 has been rejected under 35 U.S.C. § 102(e) as being anticipated by Foladare et al., U.S. Patent Number 5,905,777 (hereinafter Foladare). Claims 20-22, 24, and 25 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Quinn, U.S. Patent Number 5,944,786 (hereinafter Quinn). The Applicant respectfully traverses these rejections.

Gordon

Gordon discloses a messaging system that includes a bank of direct-in-dial telephone lines that connect to a public switched telephone network and a computer system that functions

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as a commercial access provider for the Internet. The Gordon messaging system uses the Internet and the commercial access provider functions of the computer system to deliver digital message data to an electronic mail address, facsimile telephone address, or voice mail telephone address. A recipient of the digital message data accesses the computer system using the direct-in-dial telephone lines and the PSTN to determine whether the Gordon messaging system has received any messages for the recipient.

Independent claims 1 and 9 recite a communication apparatus comprising a facsimile communication means that transmits facsimile data to a recipient over the Internet and a notification means that signals the recipient that the facsimile data is being sent. The communication apparatus manages not only the transmission of the facsimile data, but also the notification of the recipient. In contrast, the Gordon messaging system transmits facsimile data over the Internet, but requires the recipient to access the commercial access provider using a direct-in-dial telephone line over the PSTN to request any messages. Thus, Gordon cannot anticipate the Applicant's communication apparatus because Gordon does not disclose a system that transmits facsimile data and notifies the recipient of the transmission.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Ho

Ho discloses a communications device that facilitates transmitting and receiving data in accordance with both the facsimile and electronic mail communications protocols. The Ho communications device uses either the PSTN or the Internet to send facsimile data to a recipient. A sender wishing to transmit a document places the paper document to be transmitted in a

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scanner associated with the communications device, enters a destination identifier (either a telephone number or an electronic mail address), and presses a transmit button. The communications device determines whether the destination identifier is a telephone number or an electronic mail address and transmits the document in accordance with the associated communications protocol.

Independent claims 1 and 2 recite a communication apparatus comprising a facsimile communication means that transmits facsimile data to a recipient over the Internet and a notification means that signals the recipient that the facsimile data is being sent. The communication apparatus manages not only the transmission of the facsimile data, but also the notification of the recipient. In contrast, the Ho communications device provides a sender with two alternative ways to transmit the facsimile data, facsimile telephone number and electronic mail address, and requires the recipient to dial-in over the PSTN to request any messages. Independent claims 9 and 10 are similar to claims 1 and 2, but recite a communication method comprising a facsimile communication step and a notification step. Thus, Ho cannot anticipate the Applicant's communication apparatus because Ho does not disclose a system that transmits facsimile data and notifies the recipient of the transmission.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Foladare

Foladare discloses an electronic mail paging system that separates useful messages from junk mail and forwards the useful messages to a destination by the recipient. The destination that the recipient selects can be to an electronic mail server on another network, to a computer or

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a facsimile machine at the recipient's office, home, or other destination.

Independent claim 20, as presently claimed, recites a communication apparatus comprising a transmission means that transmits data to a recipient and a notification means that uses another form of transmission to signal the recipient that the transmission means is prepared to transmit the data. In contrast, the Foladare electronic paging system notifies the recipient after the electronic mail server receives a useful message. Thus, Foladare cannot anticipate the Applicant's communication apparatus because Foladare does not disclose a system that notifies the recipient that the transmission means is prepared to transmit the data.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Quinn

Quinn discloses an electronic mail notification system that monitors the retrieval activity of a message stored in an electronic mail mailbox on an electronic mail server and notifies the recipient to access the electronic mail server to retrieve the message. Forwarding software analyzes the message and generates a data signal including either an indication that the message was received, but not retrieved or an indication that the message was received and retrieved. The electronic mail notification system interprets the data signal and notifies the recipient by sending a notification message to a selected destination.

Independent claim 20 and dependent claim 21, as presently claimed, recite a communication apparatus comprising a transmission means that transmits data to a recipient and a notification means that uses another form of transmission to signal the recipient that the transmission means is prepared to transmit the data. In contrast, the Quinn electronic mail

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notification system sends the notification message in response to the electronic mail server receiving the message. Thus, Quinn cannot anticipate the Applicant's communication apparatus because Quinn does not disclose a system that notifies the recipient that the transmission means is prepared to transmit the data. The Applicant respectfully submits that the Examiner should withdraw this rejection.

Independent claim 22 and dependent claims 24 and 25, as presently claimed, recite a communication apparatus comprising a first and second means that transmit data, respectively, over a first network and a second network, and a third means that controls the transmissions by the first means and the second means. The control imposed by the third means guarantees that the data transmitted by the second means indicates that the first means is prepared to send data over the first network. In contrast, the Quinn electronic mail notification system sends the notification message in response to the electronic mail server receiving the message. Thus, Quinn cannot anticipate the Applicant's communication apparatus because Quinn does not disclose a system that notifies the recipient that the transmission means is prepared to transmit the data.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Response to the Rejection under 35 U.S.C. § 103(a)

Claims 1, 2, and 4-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper et al., U.S. Patent Number 6,052,442 (hereinafter Cooper) in view of Kulakowski, WIPO Publication Number WO 97/10668 (hereinafter Kulakowski). Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper in view of Kulakowski and further

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in view of Obhan, U.S. Patent Number 5,875,302. Claims 14-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kulakowski in view of Bobo, II, U.S. Patent Number 5,675,507 (hereinafter Bobo). Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kulakowski in view of Wegner et al., U.S. Patent Number 5,712,907 (hereinafter Wegner). Claim 23 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Quinn, U.S. Patent Number 5,944,786 (hereinafter Quinn): The Applicants respectfully traverse these rejections.

Cooper and Kulakowski Do Not Teach or Suggest All of the Claimed Limitations

Cooper discloses an integrated answering machine system that checks for electronic mail messages by calling a service provider and downloading the message. Alternatively, the Cooper system accepts a call from a service provider and accesses the service provider to download the message.

Kulakowski is discussed above in the section entitled "Response to the Rejection under 35 U.S.C. § 102(a)". For brevity, the Applicant will not repeat this discussion.

Independent claims 1, 2, 5, and 9-11, as presently claimed, recite a communication apparatus, communication method, and control method for a communication apparatus that transmits facsimile data to a recipient over the Internet and notifies the recipient before sending the facsimile data. Since the Examiner admits that Cooper fails to teach notifying the station using a PSTN that the facsimile communication through the Internet has been executed, Cooper alone cannot render obvious claims 1, 2, 5, and 9-11, as presently claimed. Furthermore, since the Kulakowski device and method sends the electronic mail message to the recipient after

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receipt of the message, the combination of Cooper and Kulakowski cannot be relied upon to render obvious claims 1, 2, 5, and 9-11, as presently claimed. Dependent claims 4, and 6-8 are allowable because they depend from allowable independent claim 2 or 5.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Cooper, Kulakowski, and Obhan Do Not Teach or Suggest All of the Claimed Limitations

Cooper and Kulakowski are discussed above in the section entitled "Cooper and Kulakowski Do Not Teach or Suggest All of the Claimed Limitations". For brevity, the Applicant will not repeat these discussions.

The Examiner relies upon the disclosure of Obhan to teach a means for selecting whether a communication is an important communication. Since Obhan fails to disclose transmitting facsimile data to a recipient over the Internet and notifying the recipient before sending the facsimile data, the Examiner relies upon Obhan in combination with Cooper and Kulakowski account for the inadequacy of Obhan.

Dependent claim 3 inherits the limitation of independent claim 1. Since the Examiner admits that Obhan does not account for the inadequacies of Cooper and Kulakowski, the combination of Cooper, Kulakowski, and Obhan cannot be relied upon to render obvious claims 3.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Kulakowski and Bobo Do Not Teach or Suggest All of the Claimed Limitations

Kulakowski is discussed above in the section entitled "Response to the Rejection under 35 U.S.C. § 102(a)". For brevity, the Applicant will not repeat these discussions.

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The Examiner relies upon the disclosure of Bobo to teach the limitations specified in dependent claims 14-16. Since Bobo fails to disclose an Internet communication execution means that establishes a dial-up connection to an Internet service provider and a notification means that signals a recipient when the dial-up connection is established, the Examiner relies upon Bobo in combination with Kulakowski to account for the inadequacy of Bobo.

Dependent claims 14-16 inherits the limitation of independent claim 12, as presently claimed. Since the Examiner admits that Bobo does not account for the inadequacies of Kulakowski, the combination of Kulakowski and Bobo cannot be relied upon to render obvious claims 14-16.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Kulakowski and Wegner Do Not Teach or Suggest All of the Claimed Limitations

Kulakowski is discussed above in the section entitled "Response to the Rejection under 35 U.S.C. § 102(a)". For brevity, the Applicant will not repeat these discussions.

The Examiner relies upon the disclosure of Wegner to teach the limitations specified in dependent claim 17. Since Wegner fails to disclose an Internet communication execution means that establishes a dial-up connection to an Internet service provider and a notification means that signals a recipient when the dial-up connection is established, the Examiner relies upon Wegner in combination with Kulakowski to account for the inadequacy of Wegner.

Dependent claim 17 inherits the limitation of independent claim 12, as presently claimed. Since the Examiner admits that Wegner does not account for the inadequacies of Kulakowski, the combination of Kulakowski and Wegner cannot be relied upon to render obvious claim 17.

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The Applicant respectfully submits that the Examiner should withdraw this rejection.

Quinn Alone Do Not Teach or Suggest All of the Claimed Limitations

Quinn is discussed above in the section entitled "Response to the Rejections under 35 U.S.C. § 102(e)". For brevity, the Applicant will not repeat these discussions.

Dependent claim 23 inherits the limitation of independent claim 22, as presently claimed. Since the Quinn electronic mail notification system sends the notification message in response to the electronic mail server receiving the message, Quinn cannot render obvious claim 23 because Quinn does not disclose a system that notifies the recipient that the transmission means is prepared to transmit the data.

The Applicant respectfully submits that the Examiner should withdraw this rejection.

Furthermore, the Applicant traverses the Examiner's assertions that "facsimile communication is a well known method of communicating data" and "computers commonly have facsimile capabilities". If the Examiner makes this rejection final, the Applicant requests, as noted in MPEP § 2144.03, that the Examiner cite a reference to support his assertions.

CONCLUSION

In view of the above Amendment and remarks, the Applicants respectfully submit that all the pending claims are patentable over the prior art of record and are now in condition for allowance. Accordingly, the Applicant respectfully requests favorable reconsideration of this case and early issuance of a Notice of Allowance.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, including any extension of time, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1232-4467.

Respectfully submitted,
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APPENDIX 1

MARKED-UP REPLACEMENT PARAGRAPHS IN THE SPECIFICATION

This appendix shows the changes made to each paragraph replaced by this Amendment relative to the previous version of the paragraph. All additions are shown underlined (e.g., the) and all deletions are shown in brackets (e.g., [the]).

REPLACE the paragraph beginning on page 2, line 24 with the following:

When a conventional facsimile apparatus executes facsimile communication from a station A to an Internet service provider (to be referred to as an ISP hereinafter) near a station B by dial-up connection, the user at the station B cannot [defect] detect arrival of the reception information of the facsimile communication at the ISP.

APPENDIX 2

MARKED-UP REWRITTEN CLAIMS

This appendix shows the changes made to each claim replaced by this Amendment relative to the previous version of the claim. All additions are shown underlined (e.g., the) and all deletions are shown in brackets (e.g., [the]).

2. (Amended) A communication apparatus comprising:

facsimile communication means for performing facsimile communication through the Internet by dial-up connection; and

reception means for, when it is notified by a calling party communication apparatus using a PSTN that communication through the Internet has been executed by dial-up connection, setting up connection to the Internet by dial-up connection and receiving facsimile communication information through the Internet by POP.

5. (Amended) A communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

display means for, when it is notified by a calling party communication apparatus using a PSTN that communication through the Internet has been executed, displaying information representing that communication through the Internet has been executed and station address information of a calling party; and

determination means for determining on the basis of selection by a user whether said apparatus is to set up connection to the Internet by dial-up connection to receive facsimile

communication information through the Internet by POP.

10. (Amended) A control method for a communication apparatus comprising:

a facsimile communication step of performing facsimile communication through the Internet by dial-up connection with a station; and

a reception step of, when it is notified by a calling party communication apparatus using a PSTN that communication through the Internet has been executed by dial-up connection, setting up connection to the Internet by dial-up connection and receiving facsimile communication information through the Internet by POP.

11. (Amended) A control method for a communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

[a display step of,] when it is notified by a calling party communication apparatus using a PSTN that communication through the Internet has been executed, displaying information representing that communication through the Internet has been executed and station address information of [a] the calling party communication apparatus; and

[a determination step of] determining on the basis of selection by user whether said apparatus is to set up connection to the Internet by dial-up connection to receive facsimile communication information through the Internet by POP.

12. (Amended) A communication apparatus capable of facsimile communication through the

Internet by dial-up connection, comprising:

Internet communication execution means for [performing] establishing a dial-up connection from a station A to an Internet service provider to execute communication with a station B having a TCP/IP address through the Internet; and

notification means for[, when communication by said Internet communication execution means has been executed,] calling the station B from the station A, when the dial-up connection is established, using a general public network to transmit information representing that facsimile communication has been executed through the Internet and description information transmitted through the Internet.

15. (Amended) The apparatus according to claim 12, wherein

said notification means further transmits [the] a number of pages of facsimile information transmitted through the Internet and a communication time.

16. (Amended) The apparatus according to [any one of claims] claim 12, further [comprising] comprising:

selection means for selecting, as the description information to be transmitted, [one of the] either summarized text representing [the] a summary of facsimile communication [and] or [the] information of [the] a first page of [the] facsimile information transmitted through the Internet.

17. (Amended) The apparatus according to claim 12, further comprising

control means for, when [the] a number of pages of [the] facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value, transmitting the facsimile information from the station A to the station B through a general public network without performing communication by said Internet communication execution means.

18. (Amended) A control method for a communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

[the Internet communication execution step of performing] establishing a dial-up connection from a station A to an Internet service provider to execute communication with a station B having a TCP/IP address through the Internet; and

[a notification step of, when communication has been executed in the Internet communication execution step,] calling the station B from the station A, when the dial-up connection is established, using a general public network to transmit information representing that facsimile communication has been executed through the Internet and description information of facsimile communication executed through the Internet.

19. (Amended) A computer-readable storage medium which stores a program for controlling a communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

a procedure code for [the Internet communication execution step of performing] establishing

a dial-up connection from a station A to an Internet service provider to execute communication with a station B having a TCP/IP address through the Internet; and

a procedure code for [the notification step of, when communication has been executed in the Internet communication execution step,] calling the station B from the station A, when the dial-up connection is established, using a general public network to transmit information representing that facsimile communication has been executed through the Internet and description information of facsimile communication executed through the Internet.

20. (Amended) A communication apparatus comprising:

transmission means for transmitting data; and

notification means for notifying, by a method different from that of [said] the transmission means, that the [data has been transmitted] transmission means is prepared to transmit the data.

22. (Amended) A communication apparatus comprising:

first means for sending data [via] over a first communication network;

second means for sending data [via] over a second communication network;

third means for controlling [said] the first means and the second means;

wherein [said] the third means controls [said] the second means so as to send data corresponding to the sending operation of [said] the first means, and
wherein the sending operation of the second means indicates that the first means is prepared to send data over the first communication network.